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EXAMINER

HENDERSON, MARK T

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 06/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,508

Applicant(s)

BERMUDEZ, MIGUEL N.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7,8,19 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7,8,19 and 21-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 2, 6, 9 and 20 have been canceled. Claims 1, 3, 4, 19, 21 and 22 have been amended for further examination.

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Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1, 3-5, 7, 8, 19, and 21-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 and 19-26 of copending Application No. 09/895,426. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications disclose an article of

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manufacturing comprising a component container, first and second labels having an identifier; wherein the identifier is also electronically stored (or encoded); wherein the first label is attached to a device and the second label is attached to a package.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1, 3-5, and 19, 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laurash et al (5,704,650) in view of Kelly, Jr and further in view of Blankenship et al (6,536,660).

Laurash et al discloses in Fig. 1, 4 and 5, an article comprising: first label (26) and second label (29), wherein each label has a printed identifier (56, as stated in Col. 7, lines 10-15); and

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However, Laurash et al does not disclose: a component container; an identifier that identifies a component inside the component container; and wherein the identifier is electronically stored in the component and read therefrom for printing labels.

Kelly, Jr. discloses an object being a component container (24) having components (20) and a device (contents inside component box (20)), wherein a label (30) is removably affixed to the component container, and has an identifier (bar code 42) that identifies the component inside the container.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Laurash et al's label to include a label having an identifier which identifies the components inside of a container, as taught by Kelly, Jr. for the purpose of keeping an inventory record.

However, Laurash et al and Kelly, Jr. do not disclose: wherein the identifier is electronically stored in the component and read therefrom for printing labels.

Blankenship et al discloses in Fig. 1-5, an identifier which can be electronically stored on a component (in this case the component is a wire), read and placed as a bar code on an adhesive label (Page 2, Par. 0008 and 0009), and wherein the adhesive label is placed on any desirable surface such as a container (reel or barrel for holding wire).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Laurash et al's and Kelly's article to include an identifier which can be electronically stored as well as encoded (bar code) on a label as taught by Blankenship et al

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for the purpose of providing the end user with tracking information which holds detailed non-deletable information pertaining to the component.

In regards to **Claims 1 and 19**, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Therefore, the identifier in Laurash et al's article can be used for printing labels.

In regards to **Claims 3, 4, 21 and 22**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the first and second label at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

4. Claims 7, 8, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over in Laurash et al as modified by Kelly, Jr and Blankenship et al, and further in view of Brower et al (6,348,685).

Laurash et al as modified by Kelly and Blankenship et al discloses an article comprising all the elements as disclosed in Claims 1 and 19.

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However, Laurash et al, Kelly and Blankenship do not disclose: wherein the container is constructed of polyester and is a electrostatic discharge bag.

Brower et al discloses in Fig. 9, an polymeric material (polyester) electrostatic discharge bag (14) container.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kelly's container and replace it with an electrostatic bag as taught by Brower et al for the purpose of holding electronic equipment.

Prior Art References

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Kelly, Jr. ('810), Patel, Wagner et al, Reilley et al, Kelly, Jr. ('030), Miller et al, and Webendorfer et al disclose label articles.

Response to Arguments

5. Applicant's arguments with respect to claims 1, 3, 4, 19, 21, 22 have been considered but are moot in view of the new ground(s) of rejection.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

May 28, 2003



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